

REMARKS

The pending Office Action addresses and rejects claims 1-20. Applicants respectfully request reconsideration based on the remarks submitted herewith.

At the outset, Applicants would again like to thank the Examiner for the courtesy of an interview on November 20, 2008. During the interview, agreement was reached with respect to the treatment of International Publication No. WO 97/18464 (“the WO ‘464 Publication”) as a prior art reference. More particularly, agreement was reached that to the extent that disclosures contained in the WO ‘464 Publication (and to that extent the Australian Provisional Application PN6619 (“the PN6619 Application”), from which the WO ‘464 Publication claims priority) are recited in the present claims, the WO ‘464 Publication is not a proper prior art reference. Because the present application claims priority from both the WO ‘464 Publication and the PN6619 Application, agreement was reached that for each claim in which each recitation of the claim is disclosed by the WO ‘464 Publication and/or the PN6619 Application, the claim has a priority date corresponding to the priority date of the WO ‘464 Publication or the PN6619 Application, respectively, and thus the WO ‘464 Publication is not a proper prior art reference with respect to that claim.

Further, although not explicitly discussed during the interview, Applicants understand that similar treatment extends to International Publication No. WO 99/46585 (“the WO ‘585 Publication,”) (and to that extent the Australian Provisional Application PP2388 (“the PP2388 Application”), from which the WO ‘585 Publication claims priority). Thus, for each claim in which each recitation of the claim is disclosed by the WO ‘585 Publication and/or the PP2388 Application (or an earlier application from which the present application claims priority, e.g., the WO ‘464 Publication and the PN6619 Application), the claim has a priority date corresponding to the priority date of the WO ‘585 Publication or the PP2388 Application, respectively, and thus the WO ‘585 Publication is not a proper prior art reference with respect to that claim.

Claim Amendments

Applicants amend claim 1 to recite that the device contains a quantity of the reagent is sufficient for a single test. Applicants amend claim 3 to remove some of the materials of the first electrode, including carbon, indium oxide, tin oxide, iridium, steel, and mixtures thereof. Applicants amend claim 6 to remove all members of the group of metal in contact with a metal salt except for silver in contact with silver chloride. Applicants amend claim 14 to recite that the heating element is located in a region of the sensing chamber. Applicants amend claim 15 to recite that the heating element includes an electrically resistive bridge that is effective to concentrate a heating effect adjacent the sensing chamber. Applicants amend claim 17 to recite that the second electrode is mounted in opposing relationship a distance of 100 microns or less from the first electrode as opposed to a distance of less than about 150 microns. Finally, Applicants cancel each of claims 8-13. Support for each of the claims can be found throughout the specification and claims, as well as the applications and patents from which the present application claims priority, as will be discussed in greater detail below. Support for the amendments to claim 14 can be found at least at page 5, lines 1-17 and page 6, lines 1-19 of the WO '585 Publication (from which the present application claims priority). Support for the amendments to claim 15 can be found at least at page 6, lines 1-19 of the WO '585 Publication. Support for the amendments to claim 17 can be found at least at page 5, lines 17-21 and page 7, lines 17-24 of the WO '464 Publication (from which the present application claims priority). No new matter is added.¹

Rejections Pursuant to 35 U.S.C. § 102(b)

The Examiner rejects claims 1-9 and 17-20 pursuant to 35 U.S.C. § 102(b) as being anticipated by the WO '464 Publication. In making the rejection, the Examiner notes that the WO '464 Publication is in the same family as foreign priority document PCT/AU96/00724 (in fact the WO '464 Publication is PCT/AU96/00724, and thus will be referred to as "the WO '464 Publication" as well), and then also notes that the present application claims priority back to the WO

¹ While reference is made to the PCT applications, Applicants note that similar support can be found in the Australian provisional applications, and thus priority dating back to the filing date of the provisional applications is appropriate.

‘464 Publication via a number of continuations and continuations-in-part. It is the Examiner’s position that each of the continuations and continuations-in-part in the chain leading from the WO ‘464 Publication to the present application do not disclose all of the claimed subject matter in the present application, and that to the extent that claimed subject matter is present in the WO ‘464 Publication but not present in each of the continuations and continuations-in-part in the chain between the WO ‘464 Publication and the present application, that such disclosures in the WO ‘464 Publication qualify as prior art.

As discussed in greater detail in a response filed by Applicants on June 26, 2008, the present application claims priority to both the WO ‘464 Publication and the WO ‘585 Publication. Each of the continuation and continuation-in-part applications filed prior to the present application properly claim priority to each of these applications. As agreed by the Examiner, to the extent that the WO ‘464 Publication discloses a recitation that the Examiner relies upon to reject the present application, reliance on the WO ‘464 Publication is only proper if that claim does not obtain a priority date back to at least a year after the publication date of the WO ‘464 Publication.² Thus, the WO ‘464 Publication is *not* appropriate prior art for any claim in which each recitation is disclosed by the WO ‘464 Publication.³

² The Examiner relies on MPEP § 201.11(I)(B) to argue that if a claim in a continuation-in-part application recites a feature not disclosed or adequately supported by a proper disclosure under 35 U.S.C. § 112 in the parent nonprovisional application, that the claim is entitled only to the filing date of the continuation-in-part application. The contrary, however, is also true, which is if a claim in a continuation-in-part application recites only features that are disclosed or adequately supported by a proper disclosure under 35 U.S.C. § 112 in the parent nonprovisional application, the claim is entitled to the filing date of the parent nonprovisional application. Independent claim 1 recites only material that was disclosed and adequately supported by a proper disclosure under 35 U.S.C. § 112 in the parent nonprovisional application, i.e., the WO ‘464 Publication, and thus priority exists back until at least that date. In fact, priority is appropriate back to the filing date of the PN6619 Application. Accordingly, the WO ‘464 Publication is not a proper prior art reference with respect to these claims.

³ The Examiner argues that *In re Lukach, Olson, and Spurlin*, 169 USPQ 795 (CCPA 1971) demonstrates that a foreign patent publication from the same patent family as an application can qualify as prior art under 35 U.S.C. § 102(b) against that application because the foreign patent publication can have a claim-anticipating disclosure without having a claim-supporting disclosure. The Examiner, however, fails to show how the disclosure of the WO ‘464 Publication is claim-anticipating without being claim-supporting. As Applicants have noted, the disclosures of the WO ‘464 Publication are nearly identical to the previous applications from which the present application also claims priority. While the Examiner notes that the Applicants only said the applications are “*nearly identical*,” Applicants reiterate that the only differences between the applications relate to priority statements at the outset of the applications and a heading related to the “SUMMARY OF THE INVENTION.” There is nothing substantively different between the disclosures

Based on the interview with the Examiner, it is Applicants' understanding that the Examiner only finds a few of the recitations of claims 1-9 and 17-20 not adequately disclosed pursuant to 35 U.S.C. § 112 by the WO '464 Publication. These recitations include: that the device contains a quantity of the reagent sufficient for *only* a single test (claim 1); that the first electrode comprises a material selected from the group that includes carbon, indium, oxide, tin oxide, iridium, steel, and mixtures thereof (claim 3); that the metal in contact with a metal salt is selected from the group that includes silver in contact with silver bromide or silver iodide and mercury in contact with mercurous chloride or mercurous sulfate (claim 6); the reagent being capable of oxidizing an analyte that comprises an antioxidant (claim 8); a reagent that is selected from the group that includes ferricyanide salts, dichromate salts, permanganate salts, vanadium oxides, dichlorophenolindophenol, osmium bipyridine complexes, and quinones (claim 9); and that the second electrode is mounted in opposing relationship a distance of less than about 150 microns from the first electrode (claim 17). Although Applicants do not fully agree with the Examiner's position, in order to expedite the prosecution of this matter, Applicants amend each of these claims to exclude the recitations that the Examiner finds unsupported by the WO '464 Publication.

Accordingly, as amended, each of claims 1-7 and 17-20 are fully supported by the WO '464 Publication, as well as the PN6619 Application, and thus each of claims 1-7 and 17-20 attain a priority date back to November 16, 1995, i.e., the filing date of the PN6619 Application. Thus, at least because reliance on the WO '464 Publication is not proper, none of the rejections directed to claims 1-7 and 17-20 can be maintained.

that the present application claims priority to and the WO '464 Publication. This instance is thus completely different than the instance in *In re Lukach*. In *In re Lukach*, the claims in question recited a range of a Mw/Mn ratio that was not fully disclosed in the foreign patent publication. While the foreign patent publication disclosed a ratio of 2.6, the claims recited a range from 2.0 to 3.0. Accordingly, the court determined that there was a claim-anticipating disclosure but not a claim-supporting disclosure. In the present application, however, there are no such claimed number ranges. Each of the recitations of independent claim 1 are fully supported in the WO '464 Publication, and thus because priority can be claimed back to the publication date of the WO '464 Publication, and in fact the PN6619 Application, the WO '464 Publication cannot serve as a prior art reference.

Rejections Pursuant to 35 U.S.C. § 103(a)

Claims 8-13

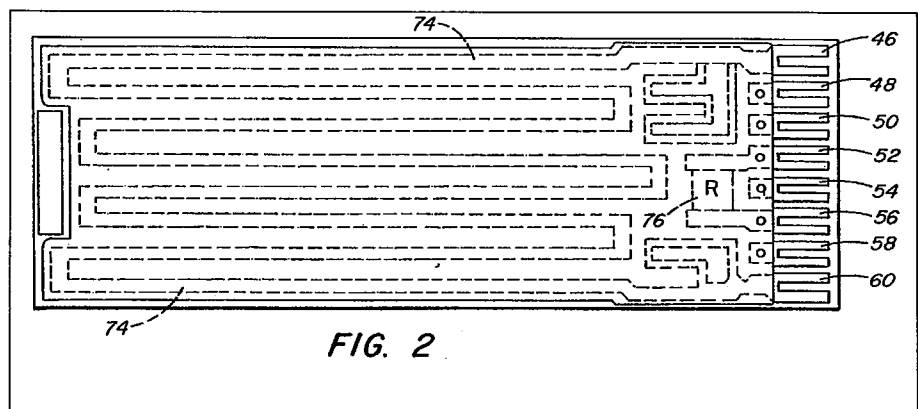
The Examiner rejects claims 8, 9, 12, and 13 as being obvious over the WO '464 Publication in view of U.S. Patent No. 5,120,420 of Nankai et al. and claims 10 and 11 as being obvious over the WO '464 Publication in view of either U.S. Patent No. 6,042,714 of Lin et al. or U.S. Patent No. 5,938,917 of Mulchandani. Although Applicants disagree that reliance on the WO '464 Publication is proper with respect to each of claims 8-13, Applicants have canceled each of the rejected claims and thus the rejections by the Examiner are moot.

Claims 14 and 15

The Examiner rejects claims 14 and 15 pursuant to 35 U.S.C. § 103(a) as being obvious over the WO '464 Publication in view of U.S. Patent No. 5,342,498 of Graves et al. ("Graves"). In particular, the Examiner relies on Graves to teach the addition of a heating element that allows the temperature of the sensor and analyte to be precisely controlled, arguing that it would have been obvious to utilize the teachings of Graves to provide a narrower sensor temperature range for the sensor of the WO '464 Publication. Applicants respectfully disagree.

Claim 14 recites a heating element that is located in a region of the sensing chamber. While the Examiner argues that Graves teaches the recited heating element, at least because it fails to teach a heating element located in a region of the sensing chamber, it fails to teach or even suggest the recited heating element. The mechanism for heating disclosed by Graves, heater 74, is a grid of heat that traverses a wiring board, as illustrated in FIG. 2, which is reproduced to the right.

(Col. 5, lines 31-39.) As



disclosed and illustrated by Graves, the heater 74 is disposed throughout the entire board and is configured to heat several sensors, not a chamber. (Col. 9, lines 53-62.) Graves fails to teach or even suggest a sensing chamber. Without a sensing chamber, there is no teaching in Graves that would lead a person of ordinary skill in the art to locate the heater 74 in a region of a sensing chamber. A person having ordinary skill in the art, attempting to incorporate the heater 74 into the device taught by the WO '464 Publication would use the entire heater 74 to heat the device, and thus also would not dispose the heater 74 in a region of the sensing chamber as required by claim 14. The recited heating element allows for efficient and controlled heating of just the sensing chamber so that the sample can be heated; the heater 74, on the other hand, heats an entire board, thereby heating sensors on the board, which is neither efficient nor controlled.

Claim 15 recites a heating element that is an electrically resistive bridge that is effective to concentrate a heating effect adjacent the sensing chamber. Graves fails to teach or even suggest an electrically resistive bridge. Graves use a plurality of external leads 46-60 to allow electrical current to be supplied to the heater grid 74. There is no teaching or suggestion that indicates that the heater 74 includes a resistive bridge. Further, the heater 74 of Graves also fails to concentrate a heating effect adjacent the sensing chamber. As discussed with respect to claim 14, the heater 74 is a grid, and Graves does not teach concentrating heat to one particular area of the board 10. Graves also does not include a chamber, and so in addition to failing to teach or even suggest concentrating a heating effect, it does not teach or even suggest concentrating a heating effect adjacent a sensing chamber.

Accordingly, both claims 14 and 15 recite patentable subject matter in view of the WO '464 Publication and Graves. Allowance of each claim is thus requested.

Claims 14-16

The Examiner rejects claims 14-16 pursuant to 35 U.S.C. § 103(a) as being obvious over the WO '464 Publication in view of the WO '585 Publication. As discussed above, and in greater detail in a response filed by Applicants on June 26, 2008, the present application claims priority to the WO' 585 Publication, which in turn claims priority to the PP2388 Application. Each of the

continuation and continuation-in-part applications filed prior to the present application properly claim priority to the WO '585 Publication and the PP2388 Application. Just as the Examiner agreed that, to the extent that the WO '464 Publication discloses a recitation that the Examiner relies upon to reject the present application, such reliance is only proper if that claim does not obtain a priority date back to at least a year after the publication date of the WO '464 Publication, to the extent that the WO '585 Publication discloses a recitation that the Examiner relies upon to reject the present application, reliance on the WO '585 Publication is only proper if that claim does not obtain a priority date back to at least at year after the publication date of the WO '464 Publication.⁴ Thus, the WO '585 Publication is *not* appropriate prior art for any claim in which each recitation is disclosed by the WO '585 Publication.⁵

Each of the recitations of claims 14-16 are fully supported by the WO '585 Publication, as well as the PP2388 Application, and thus each of claims 14-16 attain a priority date back to March 12, 1998, i.e., the filing date of the PP2388 Application. For example, a heating element (claim 14) that includes an electrically resistive bridge (claim 15) and a heating element (claim 14) that includes an exothermic substance (claim 16), both located in a region of the sensing chamber (claim 14) is disclosed at least at page 3, lines 7-11 and lines 21-22, and page 4, line 22 to page 7, line 5 of the WO '585 Publication.⁶

Accordingly, claims 14-16 are fully supported by the WO '585 Publication, as well as the PN2388 Application, and thus each of claims 14-16 attain a priority date back to March 12, 1998, i.e., the filing date of the PN2388 Application. Thus, at least because reliance on the WO '585 Publication is not proper, none of the rejections directed to claims 14-16 can be maintained.

⁴ See *supra* note 2 (discussing appropriate priority claim back to the PN6619 Application).

⁵ See *supra* note 3 (discussing the WO '464 Publication not being a proper prior art reference).

⁶ Applicants direct the Examiner's attention to the WO '585 Publication because that is the reference that the Examiner relies upon in his rejection, although similar disclosures are also located in the PP2388 Application, which in turn allows for priority to be claimed back to the filing date of the PP2388 Application.

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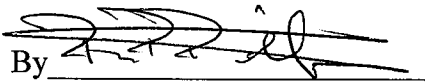
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Conclusion

In view of the reasons set forth above, each of the presently pending claims in this application is believed to be in condition for allowance, and reconsideration is respectfully requested. The Examiner is urged to telephone the undersigned Attorney for Applicants in the event that such communication is deemed to expedite prosecution of this matter.

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Respectfully submitted,

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